

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Guerney D. H. HUNT et al.

Serial No: 10/650,107

Filed: August 26, 2003

For: TIME-BASED MULTI-TIERED
MANAGEMENT OF RESOURCE SYSTEMS

Examiner: KAWSAH, Abdullah Al

Art Unit: 2195

PETITION TO DIRECTOR UNDER 37 CFR §1.181

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Petition is made under 37 CFR §1.181 to review the finality of the Final Rejection mailed January 3, 2008 ("FOA") for the above-referenced patent application.

Statement of the Facts

Claim 9

In the Office Action dated May 25, 2007, claim 9 was rejected under 35 U.S.C. § 103 based on the alleged teachings of "The Use of Life Expectancy to Manage Lotus Notes® Email Storage" by William "Bucky" Pope and Lily Mummert ("Bucky") at page 3, column 2, lines 18-25 and Figure 2. OA 5/25/07, pp. 8. The Office Action did not cite any other passages of Bucky as disclosing the subject matter of claim 9.

On August 27, 2007, in response to the May 25, 2007 Office Action, the Applicants argued that page 3, column 2, lines 18-25 of Bucky does not disclose "wherein calculating the life expectancy of the containers includes adjusting the life expectancy of the containers to account for container lead-time," as recited in claim 9. Amendment, pp. 20. Claim 9 was not amended in the response. Amendment, pp. 4.

In the Final Office Action of November 20, 2007, claim 9 was rejected

based on the alleged teachings of Bucky at page 3, column 1, lines 1-14. FOA 11/20/07, pp. 5. The cited passage was never argued in a previous office action as teaching the subject matter of claim 9.

Claim 11

Claim 11 was rejected under 35 U.S.C. § 103 in the Office Action dated May 25, 2007 in view, in part, on "Advances in Windows NT Storage Management" by Luis Felipe Cabrera, Brian Andrew, Kyle Peltonen and Norbert Kusters ("NT"). OA 5/25/07, pp. 9. The Office Action alleged,

As per claim 11, Bucky in view of Tivoli discloses all the elements of claim 11 except ***includes compressing data within the resource tier until the resource tier is in compliance with the management policy.***

On the other hand NT discloses:

- ***wherein automatically attempting to bring the resource tier in compliance with the management policy includes compressing data within the resource tier until the resource tier is in compliance with the management policy*** (page 6 col 1 lines 27 - 29, "storage management services that are described in this section help administer large collections of files. Some save storage, complementing the role of data compression"). OA 5/25/07, pp. 10 (emphasis in original).

In response to the May 25, 2007 Office Action, the Applicants argued that page 6, column 1, lines 27 - 29 of NT does not disclose "compressing data within the resource tier until the resource tier is in compliance with the management policy," as recited in claim 11. Amendment, pp. 23. Claim 11 was further amended in the response to recite,

11. (currently amended) The method of claim 1, wherein ~~automatically attempting to bring the resource tier in compliance with the management policy~~ ***increasing available capacity in containers*** includes compressing data within the resource tier until the resource tier is in compliance with the management policy. Amendment, pp. 4.

The Final Office Action of November 20, 2007, again rejected claim 11 under 35 U.S.C. § 103. FOA 11/20/07, pp. 6. This time, however, the Examiner rejected claim 11 as obvious, in part, in view of U.S. Patent No. 5,960,169 to Styczinski ("Styczinski"), alleging,

21. As per claim 11, Tivoli and Bucky discloses all the

elements of claim 11 except includes compressing data within the resource tier until the resource tier is in compliance with the management policy.

22. However, Styszcinski teaches that increasing available capacity in containers includes compressing data within the resource tier until the resource tier is in compliance with the management policy (col 15, lines 15-32). FOA 11/20/07, pp. 6.

Styszcinski was never cited in a previous office action as teaching the subject matter of claim 11.

No information disclosure statements were submitted after the non-final Office Action mailed on May 25, 2007.

Argument

According to 37 C.F.R. 1.113, final rejections can only be made on the second or any subsequent examination or consideration by the examiner. Moreover, MPEP § 706.07(a) states "Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

A new ground of rejection is created when an examiner designates a new "particular part relied on" or relies on a "different portion" of a reference. In re Wiechert, 370 F.2d 927, 933, 152 USPQ 247, 251-52 (CCPA 1967) ("An applicant's attention and response are naturally focused on that portion of the reference which is specifically pointed out by the examiner. . . . [W]hen a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-à-vis such portion of the reference").

In interpreting the term "new ground" in 37 C.F.R. § 1.196(b) the court stated, "Where the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence." In re DeBlauwe, 736 F.2d 699, 706 n. 9, 222 USPQ 191, 197 n.9 (Fed. Cir. 1984); In re Kronig, 539 F.2d 1300, 1302, 190 USPQ 425, 426 (CCPA

1976) ("the ultimate criterion of whether a rejection is considered 'new' in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection"). In re Eynde, 480 F.2d 1364, 1370-71, 178 USPQ 470, 474 (CCPA 1973) ("We do agree with appellants that where the board advances a position or rationale new to the proceedings . . . the appellant must be afforded an opportunity to respond to that position or rationale by the submission of contradicting evidence. This court so held in In re Moore, [444 F.2d 572, 170 USPQ 260 (CCPA 1971)], and we expressly reaffirm that view. The board's refusal to consider evidence which responds to such a new rationale is error.") MPEP § 1207.03(III) (deferring to the Kronig line of case law for the definition of the term "new ground"). Ex parte Teeple, Appeal No. 97-0943 at 9 (BPAI Feb. 17, 1998).

In the present case, the Final Office Action of November 20, 2007 advances new positions for rejecting claims 9 and 11. With respect to claim 9, the Final Office Action argues for the first time that based in part on the alleged teachings of Bucky at page 3, column 1, lines 1-14 this claim is obvious. The Applicants submit that the subject matter of claim 9 was not amended in the Response to Office Action filed August 27, 2007. Furthermore, the ground of rejection is clearly not based on information submitted in an information disclosure statement. Therefore, the Applicants respectfully submit that issuance of a final rejection is improper under MPEP 706.07(a).

With respect to claim 11, the Final Office Action of November 20, 2007 relies on a new reference (Styczinski) as the basis for rejecting the claim. The new reference was not necessitated by the Applicants' amendment of the claim 11 since the claim limitations rejected in the Final Office Action were not changed.

For these reasons, the Applicants submit the Final Office Action of November 20, 2007 is premature and the finality of this action should be withdrawn. The Applicants have not been provided with an opportunity to fully respond to the new positions for rejecting claims 9 and 11. Moreover, the new positions for rejecting claims 9 and 11 were neither necessitated by the Applicants' amendment of the claims nor based on information submitted in an information disclosure statement.

Action Requested

For the reasons set forth above, the Applicants respectfully request the Director withdraw the finality of the Office Action of November 20, 2007.

In the event the Applicants have filed a Request for Continued Examination before this petition is granted, the Applicants request a refund of the Request for Continued Examination fee to Deposit Account 50-0510. Moreover, the RCE should not be counted against the present application if limitations on the number of RCE filing are imposed by the USPTO.

No fee is believed due with this Petition, however, should a fee be required please charge Deposit Account 50-0510. Should any extensions of time be required, please consider this a petition thereof and charge Deposit Account 50-0510 the required fee.

Dated: February 4, 2008

Respectfully submitted,

/ido tuchman/
Ido Tuchman, Reg. No. 45,924
Law Office of Ido Tuchman
82-70 Beverly Road
Kew Gardens, NY 11415
Telephone (718) 544-1110
Facsimile (866) 607-8538